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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/822,261

Filing Date: April 02, 2001

Appellant(s): KNAUS ET AL.

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James Remenick  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/30/06 appealing from the Office action mailed 3/3/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/816,152

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is now correct due to the "reply to the notification of non-compliant appeal brief" filed 3/24/08.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: the issue is whether claims **1-29 and 46-75** are patentable over certain prior art references.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 2002/0026332 A1	SNOWDEN et al.	2-2002
6,026,363	SHEPARD	2-2000

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4,827,508                    SHEAR                    5-1989

US 2001/0037219 A1            MALIK                    11-2001

Baker, D.B. "PCASSO: A Model for Safe Use of the Internet in Healthcare" Journal of AHIMA, March 2000, pp. 33-36

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 18-26, 29, 46-47, and 51-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363).

(A) Referring to claim 1, Snowden discloses a broad-band, computer-based networked system comprising (para. 77 of Snowden):

a collection of patient-based electronic medical records of a plurality of persons, at least one of which is encrypted or secured when collected, accessed, inputted, viewed, integrated or transmitted, wherein (abstract, para. 78, para. 73, and para. 77 of Snowden):

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the medical records are obtained and electronically compiled from a plurality of sources (para. 76 of Snowden);

the medical record of a person is transmitted in whole or in part only to that person and others authorized by that person (para. 79 of Snowden);

each medical record is supplemented with additional information (para. 80 of Snowden); and

additional medical records for additional persons are added to the collection (para. 2 of Snowden; the Examiner interprets “creating” to be a form of “added”);

a secure access for allowing each person to access only their own medical record (para. 106 of Snowden); and

at least another secure access for allowing said others authorized to access only that person's medical records (para. 107 of Snowden).

Snowden discloses the feature of data integrity (para. 121 of Snowden).

However, Snowden does not expressly disclose one or more medical records of the collection possess a characteristic of non-repudiation such that medical information contained within said medical records is verified as to accuracy and certified for accuracy.

Shepard discloses one or more medical records of the collection possess a characteristic of non-repudiation such that medical information contained within said medical records is verified as to accuracy and certified for accuracy (col. 13, line 54 – col. 14, line 9 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(B) Referring to claim 2, Snowden discloses wherein said medical records are electronically compiled by direct input or digital scanning of written information into a computer-readable format (para. 73 of Snowden).

(C) Referring to claim 3, Snowden discloses wherein the sources are selected from the group consisting of hospitals, clinics, physician's offices, pharmacies and combinations thereof (para. 47 of Snowden).

(D) Referring to claim 4, Snowden discloses wherein said medical records are transmissible through the Internet (para. 77 of Snowden).

(E) Referring to claim 5, Snowden discloses wherein the medical record for each person contains one or more of: a table of contents, an index, a source notation for information contained within the medical record, an electronic search tool, annotations for errors, linked annotations for errors, treatment options, health care choices, verification standards and news items relevant to the information in the medical record (para. 116 and para. 81 of Snowden).

(F) Referring to claim 6, Snowden discloses wherein the secure access and the another secure access comprise passwords or encryption keys (para. 117 of Snowden).

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(G) Referring to claim 7, Snowden discloses wherein the others authorized are selected from the group consisting of physicians, nurses, hospitals and health care institutions (para. 117 of Snowden).

(H) Referring to claim 8, Snowden discloses wherein all of the medical records of the collection possess the characteristic of non-repudiation (para. 121 of Snowden; the Examiner interprets “data integrity” to imply the characteristic of “non-repudiation”).

(I) Referring to claim 9, Snowden discloses wherein said non-repudiated medical record is primary for treatment of the patient to whom said non-repudiated medical record pertains (para. 86 of Snowden).

(J) Referring to claim 10, Snowden discloses wherein the medical information of each medical record of said one or more non-repudiated medical records is primary for treatment and thereby relied upon by medical care providers in furnishing treatment, by employees in choosing for employer benefit options, and by payors in allocating payment for services (para. 85 and para. 86 of Snowden).

(K) Referring to claim 11, Snowden does not disclose wherein the medical information of each certified medical record is certified by the patient, by the source from which said each medical record was obtained, by a system provider or by a combination thereof.

Shepard discloses wherein the medical information of each certified medical record is certified by the patient, by the source from which said each medical record was obtained, by a system provider or by a combination thereof (col. 4, line 60 – col. 5, line 11 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(L) Referring to claims 18-19, Snowden does not disclose wherein each medical record is vetted and wherein the medical information of the vetted medical record contains one or more of: corrections of incorrect information, notations of incorrect information, notations of anomalies, linking of errors, linking of anomalies, notation of discrepancies, linking of discrepancies, and combinations thereof.

Shepard discloses wherein each medical record is vetted and wherein the medical information of the vetted medical record contains one or more of: corrections of incorrect information, notations of incorrect information, notations of anomalies, linking of errors, linking of anomalies, notation of discrepancies, linking of discrepancies, and combinations thereof (col. 8, lines 44-48 and col. 14, lines 61-65 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to maintain accurate patient medical information (col. 8, lines 44-48 of Shepard).

(M) Referring to claim 20, Snowden discloses a broad-band, computer-based networked system for individual control and management of electronic medical records

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comprising a plurality of medical records representing a plurality of persons (para. 77 and abstract of Snowden).

Snowden does not disclose wherein the medical information of at least one medical record of the plurality has been vetted, such that the medical information of said at least one medical record is better than exists at a source site from which the medical record was obtained and thereby is not subject to repudiation.

Shepard discloses wherein the medical information of at least one medical record of the plurality has been vetted, such that the medical information of said at least one medical record is better than exists at a source site from which the medical record was obtained and thereby is not subject to repudiation (col. 1, lines 29-37 and col. 4, line 60 – col. 5, line 11 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(N) Referring to claim 21, Snowden does not disclose wherein the medical information of said at least one medical record is certified as to accuracy of transcription.

Shepard discloses wherein the medical information of said at least one medical record is certified as to accuracy of transcription (col. 5, lines 58-62 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for

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doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(O) Referring to claim 22, Snowden does not disclose wherein certification represents a predetermined degree of completeness, accuracy or both to said medical records.

Shepard discloses wherein certification represents a predetermined degree of completeness, accuracy or both to said medical records (col. 1, lines 30-37 and col. 5, lines 58-62 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(P) Referring to claim 23, Snowden does not disclose wherein the medical information of said medical records is further certified as correct.

Shepard discloses wherein the medical information of said medical records is further certified as correct (col. 12, lines 8-12 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

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(Q) Referring to claim 24, Snowden does not disclose wherein vetted medical records have been reviewed and corrected or annotated for errors, discrepancies and anomalies.

Shepard discloses wherein vetted medical records have been reviewed and corrected or annotated for errors, discrepancies and anomalies (col. 14, lines 61-65 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for doing so would have been to maintain accurate patient medical information (col. 8, lines 44-48 of Shepard).

(R) Claim 25 repeats the same limitations of claim 19, and is therefore rejected for the same reasons given for that claim.

(S) Referring to claim 26, Snowden discloses wherein non-repudiated medical records are primary for treatment of the person to whom each medical record pertains by all health care providers (para. 86 of Snowden).

(T) Referring to claim 29, Snowden discloses wherein access to any one medical record is restricted to the person to whom said one medical record pertains or to others designated and authorized by said person (para. 79 of Snowden).

(U) Referring to claim 46, Snowden discloses a computer system for management of patient-based medical records that contain medical information and are not subject to repudiation comprising a database of medical records pertaining to one or more subjects; a receiver for receiving the medical information pertaining to said medical

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records from one or more senders (Fig. 1 and abstract of Snowden); a process for authorizing said senders and said additional receivers according to a set of rules, wherein said set of rules is designated by said subjects; and a transmitter for transmitting at least a portion of said medical records to one or more additional receivers (para. 118 and para. 79 of Snowden; the Examiner interprets “algorithm” to be a form of “rule”).

Snowden does not expressly disclose a process for verifying the medical information received is accurate and correct by at least vetting said medical information and certifying that the portion transmitted is accurate.

Shepard discloses a process for verifying the medical information received is accurate and correct by at least vetting said medical information and certifying that the portion transmitted is accurate (col. 8, lines 44-48 and col. 13, line 54 – col. 14, line 9 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(V) Referring to claim 47, Snowden discloses wherein said database is a secure database (para. 79 of Snowden).

(W) Referring to claim 51, Snowden discloses wherein said receiver is selected from the group consisting of: modem, cellular receiver, infrared receiver, Ethernet card, facsimile,

cable modem, satellite receiver, optical, analog receiver, Internet hub, and web-server (para. 116 of Snowden).

(X) Referring to claim 52, Snowden discloses wherein said transmitter is selected from the group consisting of: modem, cellular transmitter, infrared transmitter, Ethernet card, facsimile, cable modem, satellite transmitter, analog transmitter, Internet hub, and web-server (para. 116 of Snowden).

(Y) Referring to claim 53, Snowden discloses wherein said process of authorizing comprises public key encryption, digital signatures, biometrics, certificate authorities, or user passwords (para. 117, lines 1-9 of Snowden).

(Z) Referring to claim 54, Snowden does not disclose wherein the process of verifying results in an improved accuracy or correctness of at least a portion of the medical information received from said one or more senders.

Shepard discloses wherein the process of verifying results in an improved accuracy or correctness of at least a portion of the medical information received from said one or more senders (col. 4, line 60 – col. 5, line 11 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for doing so would have been to maintain the integrity of the patient's history file (col. 6, lines 46-51 of Shepard).

(AA) Referring to claim 55, Snowden discloses wherein said non-repudiated medical records of said one ore more subjects are primary for treatment of said one or more

subjects by health care providers not involved with creating said medical information (para. 86 of Snowden).

(BB) Referring to claim 56, Snowden discloses an integrator for reception, display, analysis and modification of said medical records available to be performed on a plurality of systems of various health care providers, payors, clearinghouses, or oversight agencies (Fig. 2 and para. 78 of Snowden).

(CC) Referring to claim 57, Snowden discloses wherein said database is administered by a service provider other than said subjects, senders, and receivers (para. 104 of Snowden; the Examiner interprets “database manager” to be a form of “service provider”).

(DD) Referring to claim 58, Snowden discloses including vetting that allows said subjects to supplement said medical records with information relating to the accuracy of said medical records (para. 80 of Snowden).

(EE) Referring to claim 59, Snowden discloses wherein said medical records are owned and controlled by said subjects (para. 2 of Snowden).

(FF) Referring to claim 60, Snowden discloses wherein the collection is encrypted and secured (para. 78 of Snowden).

(GG) Referring to claim 61, Snowden discloses wherein the medical information contained within said medical records is verified as accurate and correct by a rules-based process (para. 118 and para. 121 of Snowden).

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(HH) Referring to claim 62, Snowden discloses wherein the rules-based process is computerized in whole or in part and involves screening by medical record paraprofessionals, nurses, physicians or specialist physicians (para. 118 of Snowden).

(II) Referring to claim 63, Snowden does not disclose wherein the medical information contained within said one or more non repudiated medical records is further certified as correct.

Shepard discloses wherein the medical information contained within said one or more non repudiated medical records is further certified as correct (col. 5, lines 58-62 and col. 6, lines 8-13 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for doing so would have been to verify the accuracy of the patient's medical information (col. 5, lines 10-11 if Shepard).

(JJ) Referring to claim 64, Snowden discloses wherein the medical information of each medical record can be relied upon for all aspects of treatment of the person to whom said each medical record pertains (para. 47 of Snowden).

(KK) Referring to claim 65, Snowden discloses a networked system comprising (para. 77 of Snowden):

a collection of patient-based electronic medical records containing medical information, wherein (see abstract of Snowden):

the medical records are obtained and electronically compiled from a plurality of sources (para. 76 of Snowden);

the medical records are transmitted in an encrypted fashion in whole or in part only to that person and others authorized by that person (para. 78 and para. 79 of Snowden);

each medical record is supplemented with additional information (para. 80 of Snowden); and

additional medical records for additional persons are added to the collection (para. 2 and para. 129 of Snowden); and

a capability of having multiple secure accesses for a person and others authorized by the person to access only their own medical record (para. 107 of Snowden).

Snowden does not disclose that the medical information contained within one or more medical records is verified as to accuracy and certified as to accuracy, and thereby possesses the characteristic of non-repudiation.

Shepard discloses that the medical information contained within one or more medical records is verified as to accuracy and certified as to accuracy, and thereby possesses the characteristic of non-repudiation (col. 13, line 54 – col. 14, line 9 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for doing so would have been to provide accurate and complete patient documentation to meet legal, insurance and third party medical service provider requirements (col. 6, lines 8-13 of Shepard).

(LL) Claims 66-67 repeat the same limitations of claims 61-62, and are therefore rejected for the same reasons given for those claims.

(MM) Referring to claim 68, Snowden does not disclose wherein the medical information of the one or more certified medical records has a predetermined degree of completeness, accuracy or both.

Shepard discloses disclose wherein the medical information of the one or more certified medical records has a predetermined degree of completeness, accuracy or both (col. 1, lines 30-37 and col. 5, lines 58-62 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shepard within Snowden. The motivation for doing so would have been to verify the accuracy of the patient's medical information (col. 5, lines 10-11 if Shepard).

(NN) Referring to claim 69, Snowden discloses wherein each medical record can be relied upon for treatment of the person to whom said each medical record pertains (para. 86 of Snowden).

(OO) Referring to claim 70, Snowden discloses wherein the medical information of all of the medical records of the collection possess the characteristic of non-repudiation (para. 121 of Snowden; the Examiner interprets "data integrity" to imply "non-repudiation").

(PP) Referring to claim 71, Snowden discloses wherein said non-repudiated medical record is primary for all aspects of treatment of the patient to whom said non-repudiated medical record pertains (para. 86 of Snowden).

(QQ) Referring to claims 72 and 73, Snowden does not disclose wherein the medical information of each medical record is further certified as correct and wherein each certified medical record is certified as accurate by the patient, by the source from which said each medical record was obtained, by a system provider or by a combination thereof.

Shepard discloses wherein the medical information of each medical record is further certified as correct (col. 5, lines 58-62 and col. 6, lines 8-13 of Shepard) and wherein each certified medical record is certified as accurate by the patient, by the source from which said each medical record was obtained, by a system provider or by a combination thereof (col. 4, line 60 – col. 5, line 11 of Shepard).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Shepard within Snowden. The motivation for doing so would have been to verify the accuracy of the patient's medical information (col. 5, lines 10-11 of Shepard).

(RR) Claims 74-75 repeat the same limitations of claims 18-19, and are therefore rejected for the same reasons given for those claims.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363), and further in view of Baker ("PCASSO: A Model for Safe Use of the Internet in Healthcare").

(A) Referring to claim 12, Snowden and Shepard do not disclose wherein the collection comprises medical records of more than 100,000 persons.

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Baker discloses wherein the collection comprises medical records of more than 100,000 persons (col. 3, lines 1-4 of Baker).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Baker within Snowden and Shepard. The motivation for doing so would have been to accommodate as large a customer base as possible.

Claims 13-15, 27-28, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363), and further in view of Malik (US 2001/0037219 A1).

(A) Referring to claims 13-15, Snowden and Shepard do not disclose wherein said collection complies with a federal or state standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and wherein said collection complies with all state standards of privacy and security for the geographical area in which the system operates.

Malik discloses wherein said collection complies with a federal or state standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and wherein said collection complies with all state standards of privacy and security for the geographical area in which the system operates (para. 40 and para. 59 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Snowden and Shepard. The motivation for doing so would have been to allow for communication in a secure environment (para. 40) and to be aware of the laws and regulations governing health care in each jurisdiction (para. 59 of Malik).

(B) Referring to claims 27-28, Snowden and Shepard do not disclose wherein the plurality of medical records complies with the Health Insurance Portability and Accountability Act of 1996 and which further complies with a state standard of privacy and security.

Malik discloses wherein the plurality of medical records complies with the Health Insurance Portability and Accountability Act of 1996 and which further complies with a state standard of privacy and security (para. 40 and para. 59 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Snowden and Shepard. The motivation for doing so would have been to allow for communication in a secure environment (para. 40) and to be aware of the laws and regulations governing health care in each jurisdiction (para. 59 of Malik).

(C) Referring to claims 48-50, Snowden and Shepard do not disclose wherein said secure database complies with a federal standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and which further complies with a state standard of privacy and security.

Malik discloses wherein said secure database complies with a federal standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and which further complies with a state standard of privacy and security (para. 40 and para. 59 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Snowden and Shepard. The motivation for doing so would have been to allow for communication in a secure environment (para. 40) and to be aware of the laws and regulations governing health care in each jurisdiction (para. 59 of Malik).

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363), and further in view of Shear (4,827,508).

(A) Referring to claims 16-17, Snowden and Shepard do not disclose a fee which is assessed for each access to a medical record and a fee which is assessed for maintenance of a medical record.

Shear discloses a fee which is assessed for each access to a medical record (col. 3, lines 3-14 of Shear) and a fee which is assessed for maintenance of a medical record (col. 1, lines 55-59 and col. 3, lines 3-14 of Shear).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shear within Snowden and Shepard. The motivation for doing so would have been to charge a fee in accordance with the amount

the user has used the system (col. 3, lines 11-14 of Shear) and to recover the costs of constructing and maintaining a database (col. 3, lines 3-7 of Shear).

### **Affidavits**

Applicant has submitted an affidavit to remove Snowden (60/169,065) and Malik (60/200,091) as references applied under 35 U.S.C. § 102(e)/103(a) in the previous Office Action. The declaration filed on 8/26/05 under 37 C.F.R. § 1.131 has been considered but is ineffective to overcome the Snowden and Malik references for the following reasons:

(i) MPEP Section 715.02 states the following:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830,146 USPQ 298 (CCPA 1965).

In this case, the averred statements of William A. Knaus and Richard D. Marks and the exhibits attached thereto fail to establish either conception of and/or reduction to practice **of the whole invention claimed or something falling within the claim**. As such, it is respectfully submitted there is no clear nexus between the materials and the claimed subject matter. In particular, Applicant has not pointed out specific portions of the submitted materials directly tied to the elements or features that are being claimed. Instead, Applicant has pointed out sections he believes to be related

to Snowden's invention. To the extent that the Examiner understands the submitted materials, the Brief Background and Rationale section of the document at page 4 makes references to elements not present in any of the recited claims, namely, that the "patient would be the main repository" and "carry' the results with them to all medical encounters". In addition, at page 3, the document makes references to a "trusted agent." The Examiner was unable to find, nor does Applicant point to, such features within the pending claims. As such, the Examiner cannot ascertain what invention was conceived and reduced to practice - the invention of the claims or some other invention?

#### **(10) Response to Argument**

In the Appeal Brief filed 30 October 2006, Appellant makes the following arguments:

A) The claim elements of "certification" and "non-repudiation" are not disclosed in the cited prior art, leading to an improper rejection because prima facie obviousness has not been established. Shepard does not disclose or suggest at least the elements of "certification of medical records" or "nonrepudiation of medical records" as these elements are claimed by Appellant, and, in fact, teaches away from Appellant's claims. The Examiner's re-interpretation of these elements by distorting claim terms to shoe-horn them into portions of Shepard is both hindsight and improper under the MPEP.

B) The Examiner's mutually exclusive interpretations of "accuracy" in relation to "certification" and "non-repudiation" require, inevitably, that Appellant's claims be granted.

C) Errors in the Examiner's analysis of Appellant's 1.131 Affidavit demonstrate that the rejections based on Snowden must be withdrawn.

D) Errors in the Examiner's analysis of Appellant's 1.131 Affidavit demonstrate that the rejections based on Malik must be withdrawn.

E) Claim 20 should be declared allowed.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Argument A:

In response to Appellant's argument that the elements of "certification" and "non-repudiation" are not disclosed in the cited prior art, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant's specification. The Examiner did refer to the specification, but was unable to find any definition given with precision, clarity, and deliberateness to warrant the meanings currently argued by Appellant. For example, Applicant's definition of "certification" contains exemplary or non-committal phraseology such as "may be," "may," and "for example." Similar analysis applies for Applicant's definition of "non-repudiation." Note also MPEP 2111.01 and 2173.05(a).

In response to Appellant's argument that Shepard teaches away from Appellant's claims, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the

claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, it is respectfully submitted that the primary reference of Snowden is clearly a patient-based system (note abstract of Snowden). In addition, the Examiner disagrees with Appellant's statements that Appellant's claimed invention is directed to patient-based records and that Shepard is directed to the conventional hospital-based or physician-office system, which leads one skilled in the art in exactly the wrong direction. The Examiner respectfully submits that both systems are medical information management systems. The difference between "patient-based" and "hospital-based" is simply in who created the initial records.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Argument B:

In response to Appellant's second argument, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant's specification. The Examiner referred to the specification, but was unable to find any definition given with precision, clarity, and deliberateness to warrant the meanings currently argued by Appellant. Moreover, words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the Appellant. Where an Appellant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 273 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP § 2111.01. Pursuant to 35 USC § 112, 2<sup>nd</sup> paragraph "[i]t is Appellant's burden to precisely define the invention, and not the [examiner's]." *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Therefore, it would not be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the Appellant in the written description. In addition, it is noted that where a definition set forth in the written description is merely exemplary (i.e., where Appellant uses the phrase "for example") the Examiner should not consider this a special definition.

In this case, Appellant argues that "certification" is defined in the claims and the specification (page 9 of Appeal Brief). The Examiner respectfully submits that these

portions of the specification do not set out a special definition explicitly and with reasonable clarity, deliberateness, and precision." For example, Applicant recites that "certification may simply state that the record is correct in all material respects or that the record is internally consistent" (page 16, lines 12-13 of Applicant's specification). However, this is not a special definition that has been set out with reasonable clarity, deliberateness, and precision. Instead the definition includes language such as "may" and "may be" which is merely exemplary. For these reasons, Appellant's claims were given their broadest reasonable interpretation consistent with the specification, and the Examiner applied prior art accordingly. Similar analysis applies for Applicant's definition of "non-repudiation."

Arguments C and D:

In response to Appellant's third and fourth arguments, the Examiner never required a showing of identical subject matter to the applied references. Appellant fails to sufficiently show that his invention as claimed was completed prior to the date of the applied references. The issue is not whether the affidavit shows more than what the references show, but rather, what invention did Applicant possess as of the dates averred? See MPEP section 2138.05 for a discussion of what is required to establish actual reduction to practice.

Argument E:

In response to Appellant's fifth argument, the Examiner respectfully submits that on page 16 of the Appeal Brief, Appellant recites limitations that are not in claim 20. The element of "accuracy and correctness of said at least one medical record is better than exists at the source site from which the medical record was obtained" is nowhere in claim 20. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lena Najarian/

Examiner, Art Unit 3626

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/L. N./

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May 30, 2008

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